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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,916	09/29/2003	Paul David Zarn	9047.29US01	8987
22235	7590	01/13/2006		
MALIN HALEY AND DIMAGGIO, PA 1936 S ANDREWS AVENUE FORT LAUDERDALE, FL 33316			EXAMINER KING, ANITA M	
			ART UNIT 3632	PAPER NUMBER
DATE MAILED: 01/13/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/674,916	ZARN, PAUL DAVID	
	Examiner	Art Unit	
	Anita M. King	3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6 and 8-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-36 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 8-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This is the second office action for application number 10/674,916, Accessory Mounting System for a Boat, filed on September 29, 2003.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "80" in Fig. 2. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to because reference character "72D" in Fig. 7 appears to be incorrect and should be --72B--. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be

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labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The use of the trademark VELCRO has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The disclosure is objected to because of the following informalities: on page 5, line 15 "L" should be --L₁--; on page 5, line 30, "T" should be --t--; and on page 6, line 1, "300" is used to designate a dovetail groove (Fig. 5) and rounded corners (Fig. 7).

Appropriate correction is required.

Claim Objections

Claim 1 is objected to because of the following informality: in line 6 the period after "track" should be double bracketed to show deletion, the strike through is not effective. Appropriate correction is required.

Claim 13 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The subject matter in claim 13 is redundant, the limitations are previously cited in claim 12, lines 7-9.

Claim Rejections - 35 USC § 112

Claims 1, 2, 4-6, and 8-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is an inconsistency between the language in the preamble and certain portions in the body of the claim, thereby making the scope of the claim unclear. The preamble in claim 1 clearly indicates that a subcombination is being claimed, e.g., "an accessory mounting device for mounting an accessory to a track...." This language would lead the examiner to believe that the applicant intends to claim only the subcombination of "an accessory mounting device," the accessory and the track being only functionally recited. This presents no problem as long as the body of the claim also refers to the accessory and/or the track functionally.

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The problem arises when the track is positively recited within the body of the claim, such as, "a slide connector including a first portion that fits within the track" and "the accessory mounting bracket being slide over the slide connecting in a direction generally parallel to the track." There is an inconsistency within the claim; the preamble indicates subcombination, while in at least one instance in the body of the claim there is a positive recital of structure indicating that the combination of an accessory mounting device and a track are being claimed. The examiner cannot be sure if applicant's intent is to claim merely the accessory mounting device or the accessory mounting device in combination with the track.

Applicant is required to clarify what the claims are intended to be drawn to, i.e., either the accessory mounting device alone or the combination of the accessory mounting device and the track. Applicant should make the language of the claim consistent with applicant's intent. In formulating a rejection on the merits, the examiner is considering that the claims are drawn to the combination and the claims will be rejected accordingly. If applicant indicates by amendment that the combination claim is the intention, the language in the preamble should be made consistent with the language in the body of the claims. If the intent is to claim the subcombination, then the body of the claims must be amended to remove positive recitation of the combination.

Claim 1 recites the limitation "the accessory mount" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 is an improper Markush claim because the listed elements do not share a common utility.

Claim 12 recites the limitations "the through-opening" in line 8 and "the accessory mounting device" bridging lines 12-13. There is insufficient antecedent basis for these limitations in the claim.

Claim 22 recites the limitation "the interior region" bridging lines 4 and 5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 6, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,771,897 to Ho. Ho discloses an accessory mounting device for mounting an accessory (7) to a track (6), the device comprising: an accessory mounting bracket (5); a slide connector (1) including a first portion (13, 14) that fits within the track and a second portion (11) over which the accessory mounting bracket is slid to secure the accessory mounting bracket to the track, the accessory mounting bracket being slid over the slide connector in a direction generally parallel to the track; the slide connector being generally symmetrically in cross section and generally I-beam shaped; the accessory mounting bracket being of a complementary shape to accommodate and receive the slide connector; the slide connector and accessory mounting bracket being selectively positionable within the track in a plurality of locations; wherein the slide connector includes at least two pieces (1 and 4); and an accessory (7) mounted to the accessory mounting bracket.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho. Ho discloses the claimed invention except for the limitations of the bracket and connector being plastic and the track is provided on a boat. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the material of the bracket and the connector in Ho to have been plastic for the purpose of providing an alternative, mechanically equivalent material for making the bracket and connector based on the materials suitability for the intended use. It would have also been obvious to one having ordinary skill in the art at the time the invention was made to have modified the track in Ho to have been on a boat, since it is known to mount items to a boat via a track and since such a modification would not have produced any unexpected results.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ho in view of U.S. Patent 4,209,098 to Adams. Ho discloses the claimed invention except for the limitations of the accessory being selected from the group consisting of a drink holder, a global positioning unit, a cellular phone holder, a fish locator, a fishing rod holder, and a bimini top mounting structure. Adams teaches that it is known to mount a fishing rod holder (12) to a track. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the accessory in Ho

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to have been a drink holder as taught by Adams for the purpose of providing and adjustable storage system for a fishing rod.

Allowable Subject Matter

Claims 4, 5, 8, 13-21, and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 22 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claims 24-36 are allowed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 4,194,636 to Byram et al.

U.S. Patent 4,869,378 to Miller

U.S. Patent 5,014,458 to Wagner

U.S. Patent 5,438,789 to Emory

U.S. Patent 6,152,312 to Nava et al.

U.S. Patent 6,227,505 to Van Order et al.

U.S. Patent 6,561,117 to Kell


U.S. Patent 6,591,541 to Cummings

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita M. King whose telephone number is (571) 272-6817. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Anita M. King
Primary Examiner
Art Unit 3632

January 9, 2006